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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,954	10/02/2000	Sunil K. Rao	RAO-007	3145

7590 08/08/2003
Stephen E Baldwin
751 Laurel St PMB 621
San Carlos, CA 94070

EXAMINER

SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,954

Applicant(s)

RAO ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 7-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Receipt of the amendment deposited 22 May 2003 is acknowledged. Claims 1-3 have been amended and claims 7-24 have been added. Claims 1-24 are pending and are treated below.

Election by Original Presentation

Newly submitted claims 7-24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention originally claimed is directed to:

a) a method for a real time personal purchasing transaction comprising the steps of formatting the response with a central server, and displaying the formatted response on a mobile device (claims 1-3); and

b) a real time personal purchasing transaction system comprising means for formatting a response with a central server, and means for displaying the formatted response on a mobile device (claims 4-6).

None of newly submitted claims 7-24 relies upon the formatting features recited in claims 1-6. Claims 7-24 recite inventions which would have been the subject of a restriction

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requirement had such claims been originally presented. The inventions of claims 1-6 and those of claims 7-24 recite different structures and functionalities which are considered to be patentably distinct from each other.

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Priority

This application is a Continuation-in-part of Serial No. 09/281,739, filed June 4, 1999. Disclosure which is enabling for the method and system of claims 1-6 is not found in the '739 application or in its parent case Serial No. 08/764,903, filed December 16, 1996. Disclosure enabling for claims 1-6 is present as of the filing date of the instant application, and accordingly, the critical date in determining the eligibility of prior art pursuant to 35 USC § 102 and 103 is October 2, 2000-- the filing date of the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 1: "comprising wherein comprising" is not clear.

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In claim 6: "the action" lacks antecedent basis. For examination purposes this claim has been treated as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. (U.S. Patent No. 5,664,110).

Green et al discloses a method and system for a real time personal purchasing transaction (col. 1, lines 38-47).

The method and system incorporates the sending of a transaction inquiry from an intelligent (col. 3, lines 39-41) keyboard type (col. 4, lines 48-53) mobile device (10) to a central server (12) (col. 4, lines 61-63); the transmitting of the inquiry from the central server to an information source (14) (col. 4, lines 40-42); the receiving of a response to the

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inquiry from the information source (col. 5, lines 7-15); the formatting of the response with the central server (col. 8, lines 15-34); and the displaying of the formatted response on the mobile device (col. 7, lines 13-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al (U.S. Patent No. 5,664,110) in view of Mannings (WO 99/26396).

Green et al. further discloses that a telephone communication, either cellular or wired, is established between the mobile device and the central server (see col. 3, lines 39-41; and col. 4, lines 61-63).

Green et al. does not disclose that the mobile device is a cellular telephone, per se.

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Mannings discloses, in a similar method and system (page 6, lines 1-14), the use of a mobile device which is a cordless telephone or similar device (page 7, lines 1-6). Although Mannings does not employ the vernacular "cellular", it is noted that Mannings describes "the data entry handset communicat[ing] by means of a cordless connection, using a network of radio base stations" (page 3, lines 21-24). This description is consistent with a description of a cellular telephone network.

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Green et al. to have included a telephone of the type disclosed by Mannings. Such telephone is demonstrated by Mannings as being equivalent of the mobile devices already disclosed by Green et al. in providing a device which permits a user the flexibility to move about a user location in an untethered fashion (page 6, lines 1-4). Moreover, the Mannings cordless telephone network allows a mobile device to be located such that targeted location-specific information may be transmitted to the mobile device (page 3, lines 21-25).

Response to Arguments

Applicant's arguments deposited 22 May 2003 have been fully considered but they are not persuasive.

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Applicant remarks that "Green discloses a remote ordering terminal that is a dumb data entry terminal with no mobility".

The Examiner notes that Green discloses a "smart terminal version of the DPU 10" (col. 3, line 39). Green only refers to a "dumb terminal" as an alternative embodiment to the "smart terminal previously discussed (see col. 14, lines 5-9).

Moreover, Green discloses what is considered a "mobile" device since the DPU disclosed by Green in no way differs in structure of functionality from the device recited by Applicant.

Applicant remarks that "[the Green terminal] does not have computational capabilities to perform complex tasks".

The Examiner notes that none of claims 1-6 recite "computational capabilities" or "complex tasks". Green performs the tasks recited by Applicant in the claims.

Applicant remarks that "the telephony feature is not built into the terminal nor do they [Green] teach a multifunction terminal or a multifunction device that has telephony built in, nor does Green show intelligent appliances".

The Examiner notes that claims 1-6 do not recite features commensurate with these remarks. There is no recitation that a telephony feature is "built in" to, presumably, the mobile device, or even that the mobile device, to within some definition invoked by Applicant, is "multifunctional".

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Notwithstanding this, however, the Examiner notes that Green discloses a flow of information between the DPU 10 and the merchant database. Such flow includes a telephonic communication between such elements (see col. 5, lines 7-15). To that end, the DPU does include telephony built in. The DPU of Green performs many functions, and accordingly is "multifunctional". Green also discloses a "smart" terminal version (as discussed above).

Other remarks by Applicant regarding "emerging capabilities" of the invention, the use of "MMTR", and the use of RF Tags are not commensurate in scope with the recitations of claims 1-6.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

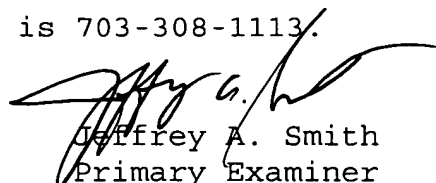
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas
August 6, 2003